<u>REMARKS</u>

Claims 1 to 31, 38 to 49, and 75 are pending. Claim 75 has been added. Claim 75 is the combination of claim 1 and further recites that a category is a group of items that possess specified attributes and represents a portion of an entire group of items having associated RFID tags. Support for claim 75 may be found throughout the specification, for example, claim 1 and on page 3, lines 8-10. No new matter has been submitted by Applicants.

Double Patenting

Applicants note the various provisional double patenting rejections and provisional obviousness-type rejections, but will not address such rejections until claims from the co-pending patent applications are allowed or issued.

§ 103 Rejections

Claims 1-17, 48 and 49 stands rejected under 35 USC § 103(a) as being unpatentable over Garber in view of Markman (US 5,794,213). Applicants hereby incorporate the arguments presented in the Office Action Response filed on August 27, 2004 relative to claims 1-17, 48 and 49.

        <u>Claims 1-17</u>: In the Response to Arguments section of the Office Action concerning independent claims 1, 8, and 18, in argument for providing the basis for combining Garber and Markman, it states, "Both Garber and Markman utilizes a tag and scanner system to facilitate and increase the processing speed of determining the information contained in the tag," Applicants respectfully disagree. Garber teaches use of a radio-frequency identification ("RFID") devices and RFID tags. Markman teaches the use of optical scan readers and barcode tags. These systems operate very differently, and in fact, RFID systems were developed to address the limitations of optical barcode systems. Moreover, Markman makes no mention of being directed at the problem of "increasing the processing speed of determining the information contained in the tag." Instead, the objects of Markman's system include: to assist in substantially manual assembly of groups of separated articles, to label articles of groups with the number of articles contained in the group, to assist in regrouping articles, to reduce waste and expense

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associated with article tags by consuming only the number needed for a particular group and avoiding any need for a stock of distinct prepared tags, and to automate assembly of groups of articles from commingled groups of articles in an inexpensive and convenient manner. (See column 4, line 65 through column 5, line 23 of Markman.) Moreover, neither reference is directed at the invention of claim 1, which is focused on changing the category of the item of interest. Instead, as discussed below, both references teach that the item of interest's category does not change based on the function, methods, and application taught within those references.

In the Response to Arguments section of the Office Action concerning independent claims 1, 8, and 18, in argument for providing the a reasoned statement why it would have been obvious to one of ordinary skill in the art to have modified the system disclosed in Garber et al. to meet the limitations of claim 1, it states, "that the reason for modifying or combining Garber and Markman was that the modification would be able to relocate where the item belongs and also confirms whether or not the item is misplaced or missing." Applicants respectfully disagree. Garber et al. makes no mention of the problem of relocating where the item belongs and confirming whether or not the item is misplaced or missing. Moreover, claim 1 is not focused on the location of the item. Instead, claim 1 is focused on categorizing the items of interest, each with an RFID tag, into a new category that it wasn't previously associated with. Garber et al. teaches a variety of functions, methods and applications, where the item of interest's category does not change, based on the function, method or application performed. Likewise, the items of Markman do not change categories. Instead, the items' category remains the same during the entire process – a group of one customer's articles for laundry and dry-cleaning. Otherwise, if the category changed during the process, the customer would not be able to retrieve his or her articles of clothing from the cleaner, because the group of their items would no longer be associated with each other, making it difficult for the cleaner to locate such items. Therefore, it is unlikely that one of ordinary skill in the art would combine two references where the item of interest's category does not change based on the function, methods, and application taught within those references to provide the invention of claim 1, which is focused on changing the category of the item of interest.

In the Response to Arguments section of the Office Action concerning independent claims 1, 8, and 18, in argument for providing a method for categorizing, it states, "Examiner

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believes that Markman teaches the garments are not physically located within its category, and hence Markman scans the tags to regroup them such that the garments are physically categorized within its assigned category. And such teaching teaches that the item of interest is not currently associated with the category selected and thereafter associating information related to the at least one item obtained with the category selected." Applicants respectfully disagree. Throughout the entire process taught by Markman, the category of the item does not change. That is, the item is always one member of a group of items for a particular customer. Even when the garments are regrouped to be physically located in the same storage location 84, they are still in the same category – a group of one customer's articles. In fact, the category of the group of one customer's articles, which is manifested in the identification code 34, is actually used to determine whether or not the article is part of the group, and if so, to either put it into a unoccupied storage location 84 (if it's the first article of the group encountered) or to put it in the already selected storage location 84 (if previous articles of the group were encountered). Moreover, if the category changed during the process, the customer would not be able to retrieve his or her articles of clothing from the cleaner, because the group of their items would no longer be associated with each other, making it difficult for the cleaner to locate such items. In contrast, claim 1 requires the steps of: (a) *selecting a category* of items using a user interface associated with an RFID reader; (b) using the RFID reader to interrogate at least one RFID tag associated with an item of interest to obtain information associated with the item of interest, *wherein the item of interest is not currently associated with the category selected in step (a)*; and (c) thereafter *associating information related to the at least one item obtained in step (b) with the category selected in step (a)*.

As a result, Markman or Garber et al., whether taken alone or in combination, do not teach a function, method, or application where a user is seeking to make an association between a new category and some item of interest that is <u>not</u> currently associated with that category, and thereafter associates the information related to the item of interest with the new category selected.

Thus, independent claims 1 and 8 recites elements not disclosed by Garber et al. or Markman, whether taken alone or in combination, and should be allowable. Claims 2-7, which depend from claim 1 and add further limitations, should also now be allowable. Claims 9-17,

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which depend from claim 8 and add further limitations, should also now be allowable. Therefore, Applicants respectfully request the rejection of claims 1-17 under 35 U.S.C. § 103(a) over Garber et al. in view of Markman be withdrawn.

Claims 48-49: Regarding claims 48 and 49, the Office Action states that the group identification of each article is read by scanning a barcoded group code and article count and *the location of the group is located, which is considered as categorizing*. (emphasis added) Applicants disagree. Markman teaches that the garments to be cleaned are first categorized into a group, such as one customer's articles. Then, after the cleaning process, the garments are regrouped into their original group. Thus, the garment's category does not change. It does not matter that the garments are temporarily stored in a location while the group is being regrouped. During this process the garment's category remains the same – a group of one customer's articles.

In addition, the Examiner acknowledges that Garber et al. does not teach the method of claim 48. And, there is no teaching in Markman of interrogating items not arranged in a particular order, organizing the information obtained in an order associated with their desired locations of the items in a storage area, and then providing the organized information to a user. Therefore, the rejection is unsupported by the art and should be withdrawn.

Therefore, claim 48 recites elements not disclosed by Garber et al. and should be allowable. Claim 49, which depends from claim 48 and adds further limitations, should also be allowable. Therefore, Applicants respectfully request the rejection of claims 48-49 under 35 U.S.C. § 103(a) over Garber et al. in view of Markman be withdrawn.

Claims 18-24: Claims 18-24 stands rejected under 35 USC § 103(a) as being unpatentable over Garber in view of Markman and Harrison et al. (US 6,176,425).

Applicants hereby incorporate the arguments presented in the Office Action Response filed on August 27, 2004 relative to claims 18-24.

Applicants have responded to the Response to Arguments section of the Office Action concerning independent claims 1, 8, and 18 above, and that response is hereby incorporated relative to claim 18 in this section.

In regard to Harrison with respect to claim 18, the Examiner acknowledges that Garber et al. and Markman do not teach step (d) in claim 18. Harrison teaches the matching of a

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tag identification number to a specific function to be performed by a computer such as "to unlock an electronically controlled door, to display a graphical image on a computer display, or login into a computer network, etc." (See Column 10, Lines 13-37 of Harrison.) "After an electronic tag is read, the computer system 12 is used to interpret the identification number of the electronic tag and provide the requested digital service. Semantic binding of the identification number can be provided by a computer 14 ..." (See, Column 9, Lines 1-8 of Harrison.) "For example, a database format can be constructed in which each identification number of an electronic tag is a database key. Associated with that key is a set of digital actions to undertake when that identification number of an electronic tag is detected. There is an enumerated list of such actions – display a Web page, display a text document, display a date in a calendar, go to a certain location in a document, and so forth." (See, Column 9, Lines 28-35 of Harrison.) Therefore, it is clear that the segment of Harrison cited by the examiner does not teach that if an item to which an RFID tag is attached cannot be categorized into one of the categories that the operator has selected, that the act of categorizing the item can be ignored, as recited in claim 18. The teaching of Harrison to ignore an ID tag if there is no mapped computer command does not, can not teach that when one is categorizing items, that if an item does not fit into one of the categories into which a user is categorizing items, that the user need not categorize the item. Therefore, contrary to the Examiner's assertion that Harrison teaches element (d); the rejection is unsupported by the art and should be withdrawn.

As a result, claim 18 recites elements not disclosed by Garber et al. or Markman or Harrison, whether taken alone or in combination, and should be allowable. Claims 19-24, which depend from claim 18 and add further limitations, should also now be allowable. Therefore, Applicants respectfully request the rejection of claims 18-24 under 35 U.S.C. § 103(a) over Garber et al. in view of Markman and Harrison be withdrawn.

Claims 25-31: Claims 25-31 stands rejected under 35 USC § 103(a) as being unpatentable over Garber et al. (US 6,232,870) in view of DeBrouse (US 5,920,053). Applicants believe claims 25-31 are allowable over Garber et al. (U.S. Pat. No. 6,232,870) in view of DeBrouse for at least the following reasons.

First, Applicants respectfully submit that the Examiner has not made out a prima facie case of obviousness based on Garber et al. in view of DeBrouse because there is no basis for

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combining Garber et al.'s devices, applications, and methods of using a portable RFID device with a group of items each having an RFID tag, with DeBrouse's system and methods of sorting airline baggage using bar coded tags. There must be some suggestion in the prior art to make the combination. Absent such a showing in the prior art, the Applicants' teaching has been impermissibly used to hunt through the prior art for the claimed elements and combine them as claimed. (See, M.P.E.P. §2143.)

Second, Applicants respectfully submit that the Examiner has not made out a prima facie case of obviousness based on Garber et al. in view of DeBrouse, because there is no reasoned statement that explains why it would have been obvious to one of ordinary skill in the art to have modified the system disclosed in Garber et al. to meet the limitations of claim 25. Instead, there is only a cursory statement that "[i]t would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of DeBrouse to the teaching of Garber to provide an indication that the interrogated tag is not in the database, such that the database can further be updated with such information for tracking purposes." (Office Action at page 9). Accordingly, the applied rejection is believed to be faulty, and if the Examiner proposes to provide any reasoning supporting the rejection then Applicants respectfully request a second non-final Office Action be issued so that Applicants may learn what that reasoning is and reply to it. (See, M.P.E.P. §2143.)

Third, even if the rejection were properly supported by argument, Applicants submit that claim 25 recites elements not shown, taught, or suggested by Garber et al. and DeBrouse, whether taken alone or in combination. In the Office Action, the Examiner acknowledges that Garber et al. does not teach step (c) of independent claim 25, which is the step of providing an indication to a user the RFID reader interrogates an RFID tag that does not match an entry on the database. Applicants assert that DeBrouse also does not disclose step (c).

DeBrouse teaches that when a passenger purchases or presents an airline ticket at the check-in counter, he presents his baggage to be checked or carried on by the passenger, and a baggage tag 80 is generated for each piece of baggage. (See column 4, lines 20-65.) DeBrouse teaches that each piece of passenger baggage 290 with a baggage tag 80 is affixed to it is scanned by the baggage scanning system 230 prior to loading the baggage into the cargo hold 240 of the departing flight. Figure 5 illustrates a baggage tag 80 in detail, and it includes the passenger

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identification bar code 122, baggage identification bar codes 112, etc. (See column 5, lines 52-57, and column 6, lines 10-20.) DeBrouse teaches that the scanning device 230 compares the passenger identification bar code 122 and the baggage identification bar code 112 on each baggage tag 80 to the computer file of scanned passenger identification bar codes 122 on each boarding pass 120. An exception report 260 is generated and displayed showing the passenger name 124, identification number 122, and baggage identification numbers 112, 112A, 112B for any passenger whose luggage was scanned for loading on a particular flight, which doesn't match the enplaned passenger file information. If an error has occurred in loading the baggage in the cargo hold is identified, the exception baggage is then removed from the cargo hold. (See column 5, line 58 through column 6, line 9.) Therefore, DeBrouse teaches that every piece of baggage does have a baggage tag 80 attached to it, that each piece of baggage is affiliated with a passenger, and that information related to the baggage tag 80 and its affiliated passenger is listed on the Airline Computer System 20. As a result, it is not possible for the barcode scanner to read a baggage tag that does not match an entry on the database.

In contrast, claim 25 recites providing an indication to a user the RFID reader interrogates an RFID tag that *does not match an entry on the database*. One non-limiting example of the method steps recited in claim 25 is illustrated in the specification starting on page 5, lines 5 to 14. For example, during data collection, the RFID reader may provide audible and/or visual feedback to indicate when the RFID reader detects an RFID tag that does not match an entry on an existing database. For example, a lighted indicator may indicate that an RFID tag has been interrogated that does not match an entry on an existing database of items. The benefit of this feature is to alert a user when an article, for example a book, is interrogated and an entry on the database indicates the book's status is checked out, or the book is not found on the library's database of books, and thus, the book might be from another library or for some other reason, it is not recorded on their database system.

As a result Garber et al., or DeBrouse, whether taken alone or in combination, do not teach a function, method, or application where a user is provided an indication to a user the RFID reader interrogates an RFID tag that does not match an entry on the database.

Thus, claim 25, recites elements not disclosed by Garber et al. or DeBrouse, whether taken alone or in combination, and should be allowable. Claims 26-31, which depend from

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claim 25 and add further limitations, should also now be allowable. Therefore, Applicants respectfully request the rejection of claims 25-31 under 35 U.S.C. § 103(a) over Garber et al. in view of DeBrouse be withdrawn.

Claims 38-41: Claims 38-41 stands rejected under 35 USC § 103(a) as being unpatentable over Garber in view of Carter (US 3,593,291). Applicants believe claims 38-41 are allowable over Garber et al. in view of Carter for at least the following reasons.

First, Applicants respectfully submit that the Examiner has not made out a prima facie case of obviousness based on Garber et al. in view of Carter because there is no basis for combining Garber et al.'s devices, applications, and methods of using a portable RFID device with a group of items each having an RFID tag, with Carter's system and methods of identifying a holder of a coded credit card and the like. There must be some suggestion in the prior art to make the combination. Absent such a showing in the prior art, the Applicants' teaching has been impermissibly used to hunt through the prior art for the claimed elements and combine them as claimed. (See, M.P.E.P. §2143.)

Second, Applicants respectfully submit that the Examiner has not made out a prima facie case of obviousness based on Garber et al. in view of Carter, because there is no reasoned statement that explains why it would have been obvious to one of ordinary skill in the art to have modified the system disclosed in Garber et al. to meet the limitations of claims 38-41. Instead, there is only a cursory statement that "[i]t would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Carter to the teaching of Garber in order to simultaneously process multiple functions at the same time to reduce the processing time and provide the user with faster response." (Office Action at page 10.) Accordingly, the applied rejection is believed to be faulty, and if the Examiner proposes to provide any reasoning supporting the rejection then Applicants respectfully request a second non-final Office Action be issued so that Applicants may learn what that reasoning is and reply to it. (See, M.P.E.P. §2143.)

Third, even if the rejection were properly supported by argument, Applicants submit that claims 38-41 recite elements not shown, taught, or suggested by Garber et al. and Carter, whether taken alone or in combination. In the Office Action, the Examiner acknowledges that Garber et al. does not teach step (b) of independent claims 38-41, which is the step of simultaneously using

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information obtained in step (a) for a second purpose of determining the presence or absence of

the items in the storage area. Applicants assert that Carter also does not disclose step (b).

Carter teaches simultaneously checking *two separate coded information sources*, such as

a coded credit card and a coded key card bearing physically unrelated arrangements of coded

indicia to be carried by the person for the credit card holder identification. Both the credit card

and coded key card must be presented at a checking station for identification of the purchaser.

An apparatus which is suitably arranged for over-the-counter transactions reads the coded indicia

on the cards and compares it in a predetermined logical order to determine whether the coded

indicia on both cards logically correspond with one another. If the coded indicia logically

corresponds, a readout device provides a positive indication that is acceptable. (See column 1,

35-57.)

Carter et al. does not disclose the steps of:

(a) interrogating RFID tags, each associated with an item, to obtain information related to the items for a purpose *other than determining the presence or absence of the items in a storage area*; and

(b) *simultaneously using the information obtained in step (a)* for determining the *presence or absence of the items in the storage area.*

One non-limiting example of the method steps recited in claim 38, as amended, is illustrated in

the specification starting on page 7, lines 4 to 25:

In another embodiment of the present invention, for example, inventory may be conducted simultaneously with other operations of the RFID system. That is, it is known to conduct inventory of RFID-tagged items by interrogating the items for that purpose. In this embodiment of the present invention, inventory is conducted as a background operation of the RFID system, using data acquired for a different purpose. For example, a portable RFID reader may be used to interrogate items in a storage area to determine whether they are located in the proper order, location, or both, or whether they are present on a list of items in which the user is interested. This would be the primary purpose of the RFID interrogation, but the information obtained regarding those items may also be used to conduct inventory. That is, each RFID-tagged item that is interrogated to determine whether it is in the proper order relative to adjacent items is necessarily also present in the storage area, and thus an inventory database can be consulted and updated, as needed, to reflect the fact that the item is present. This background inventory operation may also be used with other RFID hardware, such as check-in/check-out devices, conversion stations (for converting items without RFID tags to items with RFID tags, the tags being associated with the items), or other such devices. In those instances, the primary operation may be to check an item into or out of a storage area, or to convert an item to an RFID-tagged item, but inventory (the secondary operation) can also be

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conducted in the background, perhaps to notify a user if the items presented for conversion are not presented in the expected order according to an order list of items.

In contrast, Carter does not teach performing simultaneous multiple operations, such as *using the same information* that is collected to *determine for a purpose other than determining the presence or absence of the items in a storage area to simultaneously conduct inventory* (i.e. determining the presence or absence of items).

Therefore, independent claims 38-41 each recite elements not disclosed by Garber et al. and Carter, whether taken alone or in combination, and should be allowable. Therefore, Applicants respectfully request the rejection of claims 38-41 under 35 U.S.C. § 103(a) over Garber et al. in view of Carter be withdrawn.

Claims 42-47: Claims 42-47 stands rejected under 35 USC § 103(a) as being unpatentable over Garber in view of Lin et al. (US 6,819,222). Applicants believe independent claims 42 and 45 are allowable over Garber et al. in view of Lin et al. for at least the following reasons.

First, Applicants respectfully submit that the Examiner has not made out a prima facie case of obviousness based on Garber et al. in view of Lin et al., because there is no reasoned statement that explains why it would have been obvious to one of ordinary skill in the art to have modified the system disclosed in Garber et al. to meet the limitations of independent claims 42 and 45. Instead, there is only a cursory statement that "[i]t would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Lin in order to quickly determine the whereabouts of the item by frequent correction and updating of the inventory list, such that the user can easily determine whether the item is accessible or not." (Office Action at page 12-13.) Accordingly, the applied rejection is believed to be faulty, and if the Examiner proposes to provide any reasoning supporting the rejection then Applicants respectfully request a second non-final Office Action be issued so that Applicants may learn what that reasoning is and reply to it. (See, M.P.E.P. §2143.)

Second, even if the rejection were properly supported by argument, Applicants submit that independent claims 42 and 45 recite elements not shown, taught, or suggested by Garber et al. and Lin et al., whether taken alone or in combination. In the Office Action, the Examiner acknowledges that Garber et al. does not teach steps (c) and (d) of independent claims 42 and 45,

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which include the steps of indicating to a user in real time that the inventory list indicates that the item is *absent* and then enabling the user in real time to correct the inventory list by confirming that the item is *present* using a user interface associated with the RFID reader (claim 42); and indicating to a user in real time that the inventory list indicates that the item is *present* and enabling the user in real time to correct the inventory list by confirming that the item is *absent* using a user interface associated with the RFID reader (claim 45). Applicants assert that Lin et al. also does not disclose steps (c) and (d).

Lin et al. teaches that with its inventory control system, while the system is running its process to locate all inventory objects of a given class, any missing inventory objects will be noted by the absence of any acknowledgement response from various RFID circuits within the storage compartments. This process continues until all items have been located, or all compartments have been examined. After the process is completed, Lin et al. teaches that after a master list of all objects is created. Then, as objects are added to and removed from inventory, the master list is updated by a system operator. (See column 6, lines 14-38.) Lin et al. does not teach indicating to a user *in real time* that the inventory list indicates the item is absent or present and then enabling a user *in real time* to correct the inventory list. Lin et al. does not provide an RFID reader to enable the user to confirm, during interrogation, that a particular item that was not found (but was expected to have been found) is missing from the storage area and then immediately correct the inventory database to indicate that the item is missing (that is, not present). Likewise, Lin et al. does not provide an RFID reader to enable the user to confirm, during interrogation, that a particular item that was found (but was expected to not have been found) in the storage area and then immediately correct the inventory database to indicate that the item is present (that is, not missing).

In contrast, claim 42 is directed towards indicating to a user in real time that the inventory list indicates that the item is *absent*; and then enabling the user to correct the inventory list in real time by confirming that the item is *present* using a user interface associated with the RFID reader. Claim 45 is directed towards indicating to a user in real time that the inventory list indicates that the item is *present*; and enabling the user in real time to correct the inventory list by confirming that the item is *absent* using a user interface associated with the RFID reader. Some

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non-limiting examples of the method steps recited in claims 42 and 45 are illustrated in the specification starting on page 8, lines 9 to 34:

> In a related embodiment of the invention, a portable RFID reader performs real-time inventory reconciliation. That is, the portable RFID reader reads the RFID tags of items located in a storage area, such as on a shelf, and then compares the list of items detected with the expected contents of the storage area based on data stored in an inventory database. .... Real time inventory information can be provided to a user regarding items that should have been found but were not, items that should not have been found but were, or other discrepancies between the actual inventory and the inventory reflected on the database. The status of an item could be updated based on the information obtained from the interrogation, and the new status could be stored in the inventory database. A particularly useful feature of real-time inventory is for the RFID reader to enable the user to confirm, during interrogation, that a particular item that was not found (but was expected to have been found) is missing from the storage area. If the user confirms that the item is missing, then the RFID reader can correct the inventory database to indicate that the item is missing (that is, not present). The reverse may also be useful – enabling the user to confirm that a particular item that was found but was thought to be missing is actually present, and thus to correct the inventory database. The corrected inventory database may be stored wherever the original inventory database was stored. This real-time reconciliation of inventory saves time, and thus is a useful feature in inventory work.
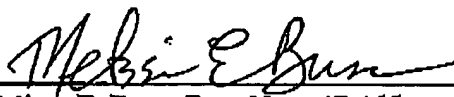
Therefore, claims 42 and 45, as amended, recite elements not disclosed by Garber et al. and Lin et al., whether taken alone or in combination, and should be allowable. Claims 43-44, which depend from claim 42 and add further limitations, should also be allowable. Claims 46-47, which depend from claim 45 and add further limitations, should also be allowable. Therefore, Applicants respectfully request the rejection of claims 42-47 under 35 U.S.C. § 103(a) over Garber et al. in view of Lin et al. be withdrawn.

Withdrawal of the outstanding rejection and allowance of the pending claims is respectfully requested and reconsideration of the application is requested. If a telephonic conference would be helpful in resolving any outstanding matters in the present application, the Examiner is encouraged to contact applicants' undersigned representative.

Respectfully submitted,

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